

REMARKS

Claims 98-137 were previously presented for the Examiner's review and consideration. In response to the Election Requirement of the Office Action, Applicant herein provisionally elects Group II, claims 118-137, with traverse.

Election/Restriction

In the Office Action, claims 98-137 were subjected to a restriction requirement under 35 U.S.C. §121. An election was required among Group I, claims 98-117, drawn to an apparatus, and Group II, claims 118-137, drawn to a method. In accordance with the requirement, Applicant hereby provisionally elects, with traverse, Group II, claims 118-137. Applicant reserves the right to file one or more divisional applications directed to the non-elected subject matter in this application.

Applicant respectfully submits that the restriction requirement was improper. An Examiner's authority to require restriction or election is defined and limited by statute. As stated in 35 U.S.C. §121, first sentence: If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions. (emphasis added).

The implementing regulations of the Patent and Trademark Office include the mandate that restriction or election is appropriate only in cases presenting inventions which are both independent and distinct, 37 C.F.R. §§1.141-142. Without a showing of independence and distinctness, a restriction or election requirement is unauthorized. In the present application, the claims which the Examiner has grouped separately are not both "independent and distinct" so as to justify the election requirement.

The courts have recognized that it is in the public interest to permit applicant to claim several aspects of their invention together in one application, as the applicant has done herein. The CCPA has observed:

We believe the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore describe in the manner required by 35 U.S.C. § 112 all aspects as to what they regard as their invention, regardless of the number of statutory classes involved. In re Kuehl, 456 F.2d 658, 666 117 U.S.P.Q. 250, 256 (CCPA 1973).

This interest is consistent with the practical reality that a sufficiently detailed disclosure supporting claims to one aspect of an invention customarily is sufficient to support claims in the same application to other aspects of the invention.

The rejection relies on MPEP §806.05(e) in stating that the process as claimed can be practiced by another materially different apparatus. The rejection recites several claim elements that are missing in the method claim as the basis for this argument. The Applicant respectfully submits that this reasoning is not consonant with the law. Indeed, it is entirely normal and expected, within the same patent, to have claims with variously fewer or more claimed elements, or even distinct claimed elements. An inquiry such as the rejection is undertaking would result in virtually every patent being subjected to restriction if it contains independent claims which are merely distinct, one from the other. It would further be illogical to state that a method claim cannot exist in an application that is not identical in all respects to the claimed elements of an apparatus claim, yet Applicant respectfully submits that this appears to be the essence of the rejection.

The rejection further states that the inventions have acquired a separate status in the art as shown by their different classification, and have a separate status in the art because of their recognized divergent subject matter. Applicant respectfully notes that reliance on an asserted “separate status in the art” does not establish independence and distinctness. This is particularly so in this case in which no support for this assertion is provided. The rejection cites reasons “given above”, but those arguments relate only to missing elements in the method claims. The rejection thus recites no basis for “recognized divergent subject matter”, and thus a requirement for restriction on this basis is improper.

Applicant respectfully disagrees that the claims in each group have a “separate status in the art” as conclusively proved by a different classification. This would have the effect of raising the classification index, implemented for convenience in searching, to the level of final arbiter of

“independent and distinct”, which it certainly is not. The rejection cites no other basis for there being a separate status in the art between the claim groups, and therefore a requirement for restriction on this basis is improper, as well.

Applicant respectfully suggests that in view of the continued increase of official fees and the potential limitation of an applicant’s financial resources, a practice which arbitrarily imposes election or restriction requirements may become prohibitive and thereby contravene the constitutional purpose to promote and encourage the progress of science and the useful arts. Moreover, under the regulatory changes as a consequence of the General Agreement on Trade and Tariffs (GATT), applicant is required to conduct simultaneous prosecution, as here, requiring excessive filing costs or to otherwise compromise the term of related patent assets.

It is vital to all applicants that election or restriction requirements issue only with the proper statutory authorization, because patents issuing on divisional applications which are filed to prosecute claims that the Examiner held to be independent and distinct can be vulnerable to legal challenges alleging double patenting.

The third sentence of 35 U.S.C. § 121, which states that a patent issuing on a parent application “shall not be used as a reference” against a divisional application or a patent issued thereon, does not provide comfort to applicants against such allegations. The Court of Appeals for the Federal Circuit has declined to hold that §121 protects a patentee from an allegation of same-invention double patenting, Studiengesellschaft Kohle GmbH v. Northern Petrochemical Co., 784 F.2d 351, 355, 288 U.S.P.Q. 837, 840 (Fed. Cir. 1986). In Gerber Garment Technology Inc. v. Lectra Systems Inc., 916 F.2d 683, 16 U.S.P.Q. 2d 1436 (Fed. Cir. 1990), the court held that §121 does not insulate a patentee from an allegation of “obviousness-type” double patenting, and in fact affirmed the invalidation on double patenting grounds of a patent that had issued from a divisional application filed following a restriction requirement. Furthermore, it is far from clear that the step of filing a terminal disclaimer is available to resolve a double patenting issue that arises after the issuance of a patent on the divisional application.

All these considerations indicate that the imposition of an election or restriction requirement with inadequate authority can lead to situations in which an applicant’s legitimate patent rights are exposed to uncertainty and even extinguished. Accordingly, to protect a

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patentee's right and to serve the public interest in the legitimacy of issued patents, Applicant respectfully urges the Examiner not to require restriction in this application, and in cases of like nature.

Conclusion

In light of the foregoing remarks, this application should be in condition for allowance, and early passage of this case to issue is respectfully requested. If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

No fee is believed to be due for this submission. It is respectfully requested that, if necessary to effect a timely response, this paper be considered as a Petition for an Extension of Time, time sufficient, to effect a timely response, and shortages in this or other fees, be charged, or any overpayment in fees be credited, to the Deposit Account of the undersigned, Account No. 500601 (Docket no. 7640-X04-019).

Respectfully submitted,

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